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OFFICE OF PETITIONS

In re Application of :
Lee and Koo :
Application No. 09/898,699 : DECISION REFUSING STATUS
Filed: 2 July, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 9898-176 :

This is in response to the petition filed under 37 CFR 1.47(b) on 15 October, 2001, which has been treated as a petition under 37 CFR 1.47(a).¹

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 2 July, 2001, without an executed oath or declaration.

¹A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign, accordingly the petition will be treated as a petition under 37 CFR 1.47(a).

Accordingly, on 22 August, 2001, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring the statutory basic filing fee, an executed oath or declaration, and a surcharge for their late filing. A two (2)-month period for reply was set.

In response, on 15 October, 2001, the present petition was filed, accompanied by the basic filing fee, the petition fee and surcharge, and a declaration naming Dong-woo Lee and Ja-il Koo as joint inventors and signed by joint inventor Koo on behalf of himself and joint inventor Lee.

Petitioners state that the non-signing inventor cannot be located.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). In regards to item (1), petitioners have not provided proof that diligent efforts have been made to locate the non-signing inventor.² Petitioners state that an affidavit and other correspondence detailing the diligent efforts made to locate the non-signing inventor was filed with the present petition. A review of the official record reveals, however, that no affidavit or other correspondence documenting the efforts made to reach the non-signing inventor are been located among the papers received on 15 October, 2001.

Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.³ Petitioners should provide a copy of the cover letter

²MPEP 409.03(d).

³MPEP 409.03(d).

transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the application is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy